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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,201	12/20/2005	Robert Van Der Geize	2002.744US	4486

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EXAMINER	
VOGEL, NANCY TREPTOW	
ART UNIT	PAPER NUMBER
1636	

NOTIFICATION DATE	DELIVERY MODE
04/06/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/537,201	VAN DER GEIZE ET AL.	
	Examiner	Art Unit	
	NANCY VOGEL	1636	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 December 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6,8-18,20 and 22-29* is/are pending in the application.

4a) Of the above claim(s) *22* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-18,20 and 23-29* is/are rejected.

7)☒ Claim(s) *2* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-6, 8-18, 20, 22-29 are pending in the case.

Claim 22 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in the reply filed on 4/9/08.

Any rejection of record in the previous action not addressed in this office action is withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 3-18, 20, 23-29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

This rejection is maintained essentially for the reasons made of record in the Office action mailed 7/10/08. To recapitulate:

To provide evidence of possession of a claimed genus, the specification must provide sufficient distinguishing identifying characteristics of the genus. The factors to be considered include disclosure of compete or partial structure, physical and/or chemical properties, functional characteristics, structure/function correlation, methods of making the claimed product, or any combination thereof. In this case, claim 1 is directed to any recombinant polynucleotide comprising a kstD promoter from any Rhodococcus; claim 3 is drawn to any recombinant polynucleotide comprising a kstD promoter comprising any function part of nucleotides 1-158 of SEQ ID NO:3; claim 4 is drawn to a recombinant polynucleotide comprising the kstD promoter from R. erythropolis, and any nucleotide sequence encoding a transcription regulator of said promoter; claim 6 is drawn to the recombinant polynucleotide comprising the kstD promoter from R. erythropolis, and any nucleotide sequence encoding any kstR gene or any homologue or functional part thereof; claim 17 is drawn to any host cell of claim 25 which does not contain a functional kstR gene or a homologue or a functional part thereof; claim 28 is drawn to a recombinant polynucleotide of claim 23 further comprising a nucleotide sequence encoding SEQ ID NO:6 or any functional part thereof. While the specification has adequate written description of the promoter of kstD from R. erythropolis, and the kstR gene of R. erythropolis, there is no disclosure on the structural limitations of the genus represented by the functional parts of the promoter, or homologues of the kstR gene, or said promoter or gene from organisms other than R. erythropolis. There is no structure/function analysis of the kstD promoter region, or the kstR gene,

which identifies regions that must be maintained, or which may be varied, and result in a functional molecule. There is no disclosure on the structural limitations of the genus represented by functional parts of SEQ ID NO:6, or methods for testing for function thereof. One skilled in the art would conclude that the disclosure of R. erythropolis kstD promoter, and kstR gene, and SEQ ID NO:6, is not representative of the undefined genus of homologues and fragments recited in the claims. Accordingly, in the absence of sufficient recitation of distinguishing identifying characteristics, the specification does not provide adequate written description of the claimed genus. Therefore, the inventor, at the time the application was filed was not in possession of the broad genus comprising kstD promoters from any Rhodococcus, functional parts of the R. erythropolis kstD promoter, and functional parts and homologues of kstR gene of R. erythropolis, and functional parts of SEQ ID NO:6 needed to practice the claimed invention.

Applicant's arguments, filed 12/10/08, have been considered but have not been found convincing.

Applicants have argued that the specification describes a genus of kstD promoters from Rhodococcus, functional parts thereof, or describes methods to determine functional parts thereof. However, it is maintained that the specification only discloses the kstD promoter from R. erythropolis disclosed in SEQ ID NO:3, nucleotides 1-158, and does not disclose any structural

information regarding the portions of said nucleotides that may be altered and retain function. Therefore, the rejection is maintained.

Claim 16 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

This rejection is maintained essentially for the reasons made of record in the previous Office action mailed 7/10/08. To recapitulate:

It is apparent that R. erythropolis RG10 is required to practice the invention. As such, the cell must be readily available or obtainable by a repeatable method set forth in the specification, or otherwise readily available to the public. If it is not so obtainable or available, the requirements of 35 U.S.C. 112, first paragraph, may be satisfied by a deposit of the strain. In the instant case, the process to generate the cell that is disclosed in the specification does not appear to be repeatable, nor does it appear the cell is readily available to the public.

If a deposit is made under the terms of the Budapest Treaty, then an affidavit or declaration by Applicants, or a statement by an attorney of record over his or her signature and registration number, stating that the instant invention will be irrevocably and without restriction released to the public upon the issuance of a patent, would satisfy the deposit requirement made herein. If a deposit has not

been made under the Budapest Treaty, then in order to certify that the deposit meets the criteria set forth in 37 CFR 1.801-1.809 and MPEP 2402-2411.05, Applicant may provide assurance of compliance by affidavit or declaration, or by a statement by an attorney of record over his or her signature and registration number showing that:

a) during the pendency of the application, access to the invention will be afforded to the Commissioner upon request;
b) all restrictions upon availability to the public will be irrevocably removed upon the granting of the patent;
c) the deposit will be maintained in a public depository for a period of 30 years, or 5 years after the last request for the enforceable life of the patent, whichever is longer;
d) a test of the viability of the biological material at the time of deposit (see 37 CFR 1.807); and
e) the deposit will be replaced if it should ever become inviable.

Failure to make one of the preceding indications in response to this Office Action will result in the rejection being maintained in either a second Non-Final or a Final rejection.

In response to this rejection, Applicant's representative has made the statement in the response of 12/10/08 that R. erythropolis RG10 will be readily available to the public upon granting of the patent ([page 12). However, the statements required as set forth above, have not been made. Applicants have

not stated that the deposit is made under the terms of the Budapest Treaty, and therefore parts a)- d) must presumably be present in the assurance or statement, which has not been done. Therefore the rejection is maintained.

Claim 2 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NANCY VOGEL whose telephone number is

(571)272-0780. The examiner can normally be reached on 7:00 - 3:30, Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on (571) 272-0951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/NANCY VOGEL/
Primary Examiner, Art Unit 1636

NV
3/30/09